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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/182,409 01/14/94 BARDEEN

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K DNI 389
EXAMINER

TALBOT, B

ART UNIT PAPER NUMBER

1112
135

1112
DATE MAILED:

06/28/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-----------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-31 are pending in the application.
Of the above, claims 16, 22-31 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-15, 17-21 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Part III DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-15 and 17-21, drawn to method, classified in Class 427, subclass 256.

Group II. Claims 16,22 and 23, drawn to a product, classified in Class 428, subclass 914.

Group III. Claims 24-31, drawn to a kit, classified in Class 156, subclass 539.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product can be made by another materially different process, i.e. directly drawing the design without a transfer sheet.

3. Inventions I and III are related as process and apparatus for its practice. Inventions are distinct if it can be shown

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that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another materially different process, i.e. metallization of a substrate.

4. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (M.P.E.P. § 806.05(g)). In this case the product as claimed can be made by another materially different apparatus, i.e. a crayon.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Timothy J. Martin on June 13, 1994 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15 and 17-21. Affirmation of this election must be made by applicant in responding to this Office action. Claims 19 and 22-31 have been

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withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-13, 17, 18 and 20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Kitabatake (4,169,169).

Kitabatake teaches a transferring process comprising the steps of: a) providing a transfer sheet comprising a substrate and a pattern layer comprising lower alcohol-soluble, water-insoluble dyes provided on at least one surface of the substrate; b) wetting the pattern layer of the transfer sheet with a transfer solution containing lower alcohols and bringing the transfer sheet into close contact with a receiving surface onto which the pattern is to be transferred in such a manner that the pattern layer contacts the receiving surface; c) maintaining the transfer sheet in close contact with the receiving surface under pressure; and d) peeling the transfer sheet from the receiving

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surface thereby to leave a transferred pattern corresponding to the pattern of the transfer sheet on the receiving surface (see abstract). The substrate 1 constituting the transfer sheet may be composed of various papers, plastic films or composite films. The pattern layer can be produced by using an ink composition containing lower alcohol-soluble, water-insoluble dyes for example by various printing means. The dyes are non-toxic to the skin (col. 2, line 61 - col. 3, line 69). The transfer pattern contains a solvent which effectively promotes drying at the time of printing and can be dried by natural drying or forced drying (col. 4, lines 43-46). In addition the solvent may be dispersed in water (col. 4, lines 41-42). The transfer solution is applied on the receiving surface onto which the dye pattern is to be transferred (col. 4, lines 55-57). The transfer pattern is then applied to the treated receiving surface and when the transfer solution has partly dried, the transfer sheet is peeled from the receiving surface (col. 5, lines 7-19). Further, when the transfer solution contains a resin, an undercoating film is formed under the transferred pattern. This film exhibits an anchoring effect for the receiving surface and at the same time, protects the dye of the transferred pattern (col. 5, line 67 - col. 6, line 15).

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

Claims 9,10,14-15,19,21 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitabatake (4,169,169) in view of Golchert (4,024,287).

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The features described above in rejecting claims 1-8, 11-13, 17, 18 and 20 over Kitabatake are incorporated here.

Kitabatake fails to teach 1) the active step of drawing the pattern on the transfer sheet as opposed to using a "pre-printed" sheet, tracing the "pre-printed" pattern, and coloring the pre-painted portions, 2) a transfer solution comprising a "stick" glue, paste or egg white and 3) the transfer pattern being a water-soluble ink.

Golchert teaches a method of decorating food items by placing a transparent shield over a selected design to be transferred to the food item. placing a sheet of thin transfer medium over the shield and design to be traced, tracing said design on the transfer medium using edible ink, placing the medium on the food item to be decorated with the colored side down, and placing a damp pad on the exposed back face of the transfer medium, thereby causing the traced design to be transferred to the food item (see abstract). The design is either drawn originally or traced onto a sheet of transfer medium, using various colors of water soluble edible type ink material (col. 1, lines 52-55). Thereafter the decorator may proceed to use colored frosting or gels to fill in the design (col. 65-67). It would have been obvious at the time the invention was made to have utilized Golchert's method or

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producing printing transfer patterns for Kitabatake's "pre-printed" transfer patterns because one skilled in the art would be able to capture the decorator "unique" creative designs. In addition, the use of transfer sheets, both "pre-printed" and "designed" are well known in the art. It is the examiner's position that one skilled in the art would have a reasonable expectation of achieving similar success by using "pre-printed" transfer sheets as opposed to "designed" transfer sheets. Therefore, without the showing of unexpected results, the difference is considered an obvious modification of one another and is deemed unpatentably distinct.

Claims 2,5-8,17-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitabatake (4,169,169) in view of Takiyama et al. (4,490,410).

Kitabatake fails to explicitly recite that the transferring solution is curable and forms a film on which the pattern is being transferred.

Takiyama et al. teaches a method of coating a stock or shaped body with an active curable resin; placing a pre-printed pattern film so as to contact the resin with the pattern at a stage where the resin still remains in a liquid or sticky gelled state prior to curing, said pattern being printed with an ink having a greater affinity to said resin than said film,

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irradiating a beam to cure the resin thereby transferring the pattern to cured resin surface, removing the film and thereafter coating the transferred pattern bearing resin surface with a translucent film (see abstract). It would have been obvious at the time the invention was made to have utilized Takiyama et al.'s resin transferring layer in Kitabatake's transfer process because of the improved water resistance associated with this type of transferring process.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) DeGoler (4,155,886)
- 2) DeVries et al. (4,058,644)
- 3) Shimomura et al. (4,826,807)

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Talbot whose telephone number is (703) 305-3775.

Brian K Talbot

bkt

June 23, 1994

Shrive Beck
SHRIVE BECK
SUPERVISORY PATENT EXAMINER
GROUP 1100